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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Pennace et al.	Group No:	2831
Serial No.:	10/017,490	Examiner:	Chau N. Nguyen
Filed:	12/14/2001		
For:	CONDUCTIVE COMPOSITE FORMED OF A THERMOSET MATERIAL		

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Commissioner for Patents
P.O. Box 1450
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Sir:

RESPONSE

This is in response to the office action mailed on July 30, 2003.

Claims 1-3, 5, 11 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Escallier et al (4,501,929) in view of Buchalter (5,330,811), and claims 4-9 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Escallier et al in view of Buchalter as applied previously to claim 1, and further in view of Bow (4,125,739).

Claims 6-8 have been indicated as being allowable if rewritten in independent form.

Claim 1 provides the broadest definition of applicants' invention, and thus the following discussion will focus on why the examiner's rejection of that claim is flawed and should, therefore, be withdrawn. The same logic applies to dependent claims 2-5 and 9-12.

35 U.S.C. 103(a) provides that a claimed invention is unpatentable if the differences between it and the prior art:

> "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." (emphasis added).

The phrase "at the time the invention was made" is the safeguard that prevents entry into the "tempting but forbidden zone of hindsight" when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F. 2d, 873, 228 U.S.P.Q. (BNA) 90.98 (Fed. Cir. 1985), overruled on other grounds.

Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher, W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. (BNA) 303, 313 (Fed. Cir. 1983).

In his latest rejection, nowhere does the examiner particularly identify any suggestion, teaching, or motivation to combine Escallier et al (multiconductor flat cable art) with Buchalter (disposable laminate drain cover art), nor does the examiner make specific or inferential findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

Instead, the examiner has merely discussed the ways that features of these disparate references might be combined to read on the claimed invention.

Escallier et al's laminate includes separated multiple runs 18 of wire conductors 20. There is no disclosure or suggestion in Escallier et al that these conductive elements might somehow be damaged by bending or flexing the laminated cable, and thus there is no motivation to employ an adhesive 22 or 30 with elastic properties to deal with this problem. Why then would the man skilled in the art look to Buchalter for an adhesive with such properties? And

even if he were so motivated, which he would not be, would he look to adhesives employed to adhere drain covers to sinks and the like? Common sense dictates that the answer to this question should be an emphatic "no"!

In fact, there is absolutely nothing in either Escallier et al or Buchalter amounting to a suggestion, teaching or motivation to combine them as the examiner is now attempting to do. Combining prior art references without evidence of these critical and essential elements simply takes the inventor's disclosure as a blue print for piecing together the prior art to defeat patentability -- the essence of hindsight. In Re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), rev'd on other grounds, 203 F.3d 1305 (Fed. Cir. 2000).

The rejection of claims 1-3, 5, 11 and 12 should be withdrawn and this case parsed to issue.

Respectfully submitted,

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